

## REMARKS

### Rejection for Obviousness-Type Double Patenting

Claims 1-17 and 24-35 have been provisionally rejected under the judicial doctrine of obviousness-type double patenting over claims 1-23 of copending Application No. 09/850,837.

Applicants respectfully delay any action until the 09/850,837 application should actually issue before the present application and the rejection become nonprovisional.

### Rejection for Under 35 U.S.C. § 102(b) over Jouck et al.

Claims 1, 4-13, 15-18, and 20-35 have been rejected under section 102(b) as anticipated by the Jouck patent, U.S. 5,322,715. Applicants respectfully traverse the rejection and request reconsideration of the claims.

It is well-settled law that to anticipate an invention, a reference "must sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining and Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992). The Federal Circuit made clear in the *Minnesota Mining and Manufacturing* case, and later in *Ultradent Products Inc. v. Life-Like Cosmetics, Inc.*, 44 U.S.P.Q.2d 1336 (Fed. Cir. 1997), that a reference cannot anticipate by merely broadly describing technology in a way that generally encompasses the invention's specific parameters.

The Jouck patent, therefore, does not anticipate Applicants' invention because it merely discloses a method of first polymerizing 10 to 90 parts by weight of a monomer or mixture of monomers selected from *all ethylenically unsaturated monomers known to*

*man*, chosen so to produce a particular glass transition temperature, followed by polymerizing 90 to 10 parts by weight of a monomer or mixture of monomers, again selected from *all ethylenically unsaturated monomers known to man*, this time chosen to produce a different glass transition temperature. The Jouck patent does not describe polymers specifically prepared with 45% by weight cycloaliphatic monomers. None of the working examples in columns 14-17 includes a cycloaliphatic monomer in *any* amount. Just like in the *Ultradent Products* case, the description encompasses many possible combinations, but doesn't specifically describe a single one that meets the requirements of the present invention. If a person in the field wished to make a refinish basecoat that have a shorter tack-free drying time, that would have metal control comparable to a basecoat including cellulose acetate butyrate without including that expensive, additional material, and that would provide particularly good jetness in a black basecoat, the Jouck patent does not disclose an acrylic composition with the type and amount of monomer that will provide these benefits. "Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference." *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp.*, 32 U.S.P.Q.2d 1496, 1503 (Fed. Cir. 1994).

The Jouck reference does not anticipate the present claims when the proper legal principles are applied. Accordingly, Applicants respectfully request withdrawal of this rejection and reconsideration and allowance of the claims.

Rejection for Under 35 U.S.C. § 103(a) over Jouck et al.

Claims 1, 4-13, 15-18, and 20-35 have been rejected under section 103(a) as obvious over the Jouck patent, U.S. 5,322,715. Applicants respectfully traverse the rejection and request reconsideration of the claims.

The Office Action proposes that the basecoat composition of the Jouck reference would either inherently or obviously be a refinish basecoat composition. Applicants believe, however, that what must be obvious is to select the amount and type of monomer to achieve the improved characteristics of the basecoat composition of the invention. Because the Jouck patent provides not guidance in how choose those monomer combinations that will provide the improved drying and pigment wetting characteristics of the present invention from those that will not, the reference cannot make the present invention obvious. There can be no expectation of success when it is merely a accident of chance whether one would select a combination that would provide the improved refinish basecoat of the present invention. Note that none of the actual examples provided meet the requirements of the present claims.

Further, the principles for selecting polymers that provide the improvements of the invention are unrelated to the characteristics that the Jouck patent does teach are essential. The Jouck patent emphasizes that the emulsion polymer must be made in two stages, with a first stage where the theoretical glass transition temperature prepared from the monomer composition is +30 to +110°C and a second stage where the theoretical glass transition temperature prepared from the monomer composition is -60 to +20°C, the difference in Tgs between the stages being 10 to 170°C. The Jouck patent is not directly to shortening dry times or improving jetness of a black. Further, it

does not appear to be predictable from the aqueous, metallic Jouck patent compositions containing thickener whether any particular acrylic composition would provide the kind benefit for metallic appearance that Applicants demonstrate in comparing Example 3 of the invention to Comparative Example B, showing that the cellulose acetate butyrate can successfully be replaced in a solvent-borne composition by the polymer described in the present claims. (The cellulose acetate butyrate is unsuitable for use in aqueous compositions, as it is hydrophobic due to its ester groups.)

Because the Jouck reference does not describe the particular polymers in the claimed refinish basecoat compositions, does not provide specific example of those polymers or basecoats containing those polymers, and provides no motivation to select those polymers and basecoat compositions over the large, general class of polymer that it teaches, the Jouck reference does not disclose or make obvious the claimed invention. Accordingly, Applicants respectfully request reconsideration and allowance of the claims.

Rejection for Under 35 U.S.C. § 102(b) over Benefiel et al.

Claims 1-35 have been rejected under section 102(b) as anticipated by the Benefiel patent, U.S. 3,639,147. Applicants respectfully traverse the rejection and request reconsideration of the claims.

One of the points of the present invention is that the cellulose acetate butyrate resins that have heretofore been included to shorten dry to handle time and improve metal control can be omitted. The cellulose acetate butyrate resins are relatively expensive, require special steps for incorporation, and have a limited manufacture.

(The undersigned believes there is one US and one Japanese manufacturer.) One of the advantages of the presently claimed compositions is that the cellulose acetate butyrate resins can safely be omitted without sacrificing either dry time (which is, in fact, significantly shortened—cut in half) or metallic appearance. See the comparison made between Comparative Example B and Example 3 (replacing the CAB with the acrylic resin of Example 1).

The Benefiel patent also does not teach or mention refinish compositions. The Benefiel compositions must be baked at relatively high temperatures, 180° to 400°F. See column 7, lines 42-45. Note the bake schedules in the examples are 30 minutes at 250°F and 30 minutes at 280°F, typical of OEM high bake cures, and even 30 minutes at 325°F and 20 minutes at 340°F, which are much higher than typical bakes in automotive plants today. Such temperatures are much too high for refinishing a vehicle, as parts on a fully-assembled vehicle would be deformed in such a bake.

The Benefiel patent does not disclose the present invention, which would require (as we have seen from the *3M* and *Ultradent* cases) more than a general disclosure of compositions that may or may not meet the requirements of the present inventive compositions containing its particular polymer. Just as in the case of the Jouck patent, no specific embodiment described in Benefiel is even close to Applicants' invention. None of the specific examples appears to include *any* cycloaliphatic monomer, let alone at least 45% by weight of a cycloaliphatic monomer. To be an anticipating reference, there must be a definite description of the invention or a description of an actual embodiment. Both of these are clearly missing from the Benefiel patent. "An anticipating reference must describe the patented subject matter

with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention." *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Anticipation requires much more than blind chance that one following the reference's teaching might unwittingly make the claimed invention.

Accordingly, Applicants respectfully request reconsideration and allowance of the claims.

Rejection for Under 35 U.S.C. § 103(a) over Benefiel et al.

Claims 1-35 have been rejected under section 103(a) as obvious over the Benefiel patent, U.S. 3,639,147. Applicants respectfully traverse the rejection and request reconsideration of the claims.

The Benefiel patent provides no guidance either for modifying its composition to make a suitable refinish basecoat composition, since the patent is concerned only with high bake composition, and provides no guidance for selecting among its carboxylic acid and hydroxyl-functional polymers those that would have at least 45% by weight cycloaliphatic monomer portions. For the purposes of the Benefiel composition, all of the acrylic polymers are the same so long as they have the required acid and hydroxyl groups. There is no motivation to select compositions according to the present invention.

There is no motivation in the Benefiel patent to make the present refinish compositions. The Benefiel patent does not even concern itself with refinish coatings.

The Benefiel patent does not disclose or suggest how one would go about preparing a refinish basecoat with shortened drying time. The Benefiel patent certainly does not suggest what modification would be necessary to obviate the use of cellulose acetate butyrate resins, since including those resins is one of its central ideas. Obviousness, on the other hand, requires much more than a possibility that the person skilled in the art might accidentally select an embodiment of the invention. The Benefiel reference, however, lacks the necessary direction.

Applicants, therefore, respectfully request reconsideration of the claims.

#### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this Reply is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

✓ Anna M. Budde

Anna M. Budde  
Registration No. 35,085

Date March 3, 2003  
Harness, Dickey & Pierce, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600